



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/729,689

12/05/2003

Steven Whitehead

1251.178

8844

21917 7590 08/11/2008
MCHALE & SLAVIN, P.A.
2855 PGA BLVD
PALM BEACH GARDENS, FL 33410

EXAMINER

PAINTER, BRANON C

ART UNIT

PAPER NUMBER

3633

MAIL DATE

DELIVERY MODE

08/11/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/729,689	Applicant(s) WHITEHEAD ET AL.	
	Examiner BRANON C. PAINTER	Art Unit 3633	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,8-25 and 28-37 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 33-36 is/are allowed.
- 6) ☒ Claim(s) 1,8-22,24,28-32 and 37 is/are rejected.
- 7) ☒ Claim(s) 23 and 25 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claim 33 is objected to because of the following informalities:
 - a. Claim 33, "floor members having, a top." For the purpose of this examination, the examiner presumes this should read "floor members having a top."
 - b. Appropriate correction is required for all the preceding objections.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:
 1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
4. Claims 1, 8-9, 13, 17, 21, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greene (U.S. Patent No. 6,796,087) in view of Silva (U.S. Patent No. 6,145,254).

Art Unit: 3633

5. Regarding claim 1:

a. Greene discloses a panel system with assemblies for a floor, a pair of side walls, a rear wall, a pivoting door that can be assembled on-site (Fig. 1), and roof panels with top, bottom, front, back, left, and right closed edges and a plurality of strengthening ribs in the bottom surface ("roof panels" 20, Fig. 25 with ribs shown in amended Fig. 25).

b. Greene does not expressly disclose that one of the roof panels telescopes.

c. Silva discloses a telescoping roof panel ("panel member" 50, Fig. 2).

Providing a roof panel of Greene with telescoping ability as taught by Silva allows added space for maneuverability when inserting lengthy tools such as rakes or ladders into the utility shed.

d. Greene and Silva are analogous art because both are from the field of endeavor of roofed structures.

e. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the roof panels of Greene by providing one of the panels with telescoping ability as taught by Silva, in order to aid in the insertion and removal of lengthy tools.

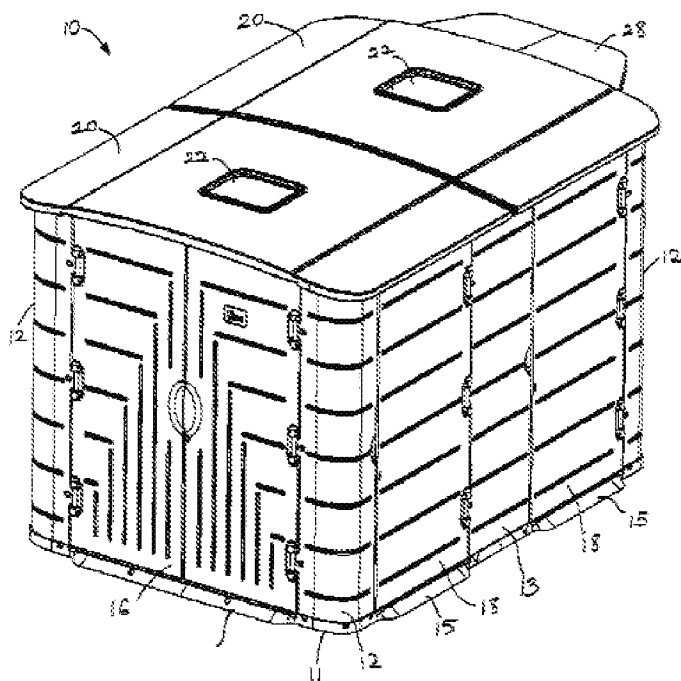


FIG. 1

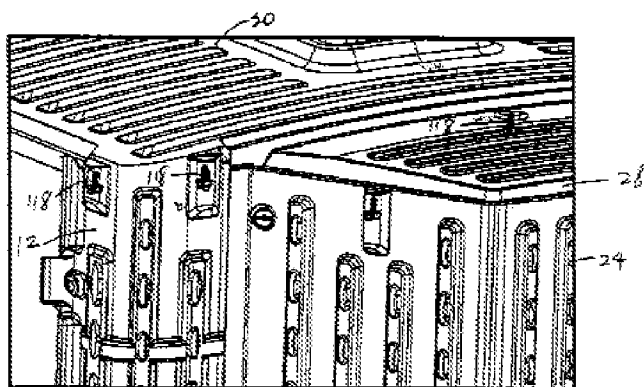
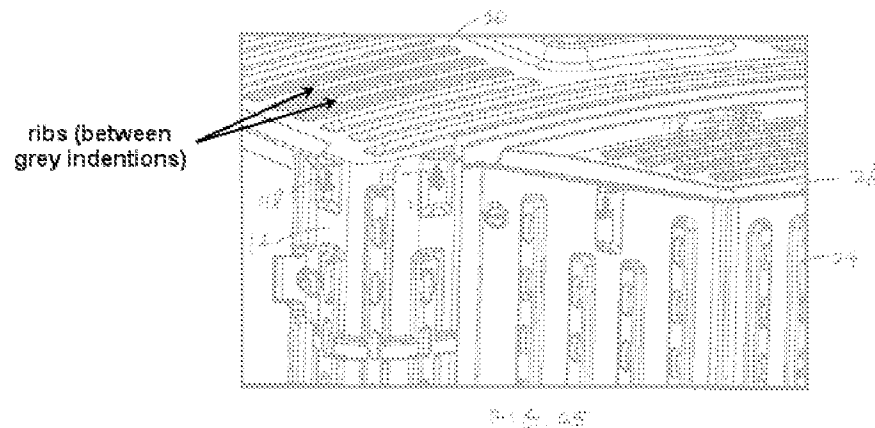


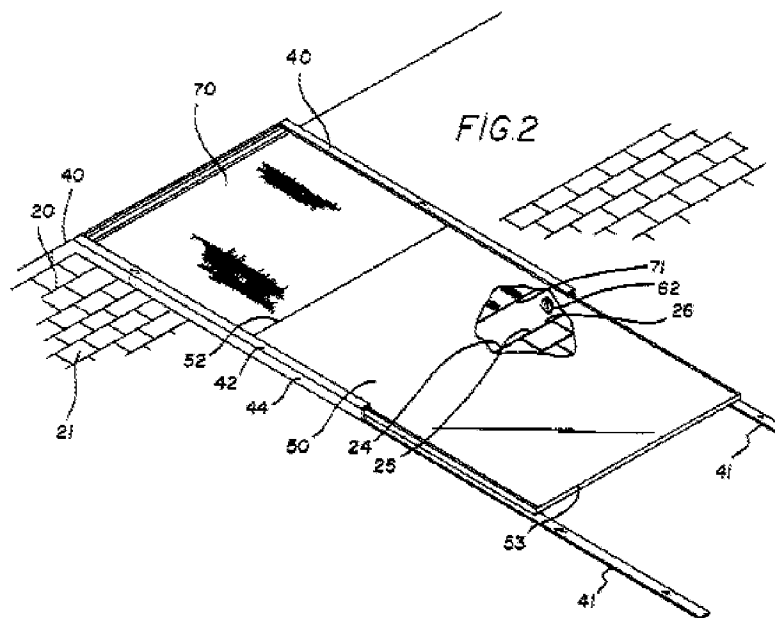
FIG. 25

Reproduced from U.S. Patent No. 6,796,087

Art Unit: 3633



Reproduced from U.S. Patent No. 6,796,087 (amended)

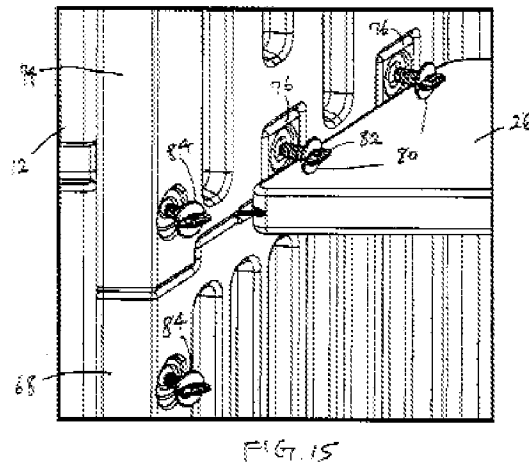
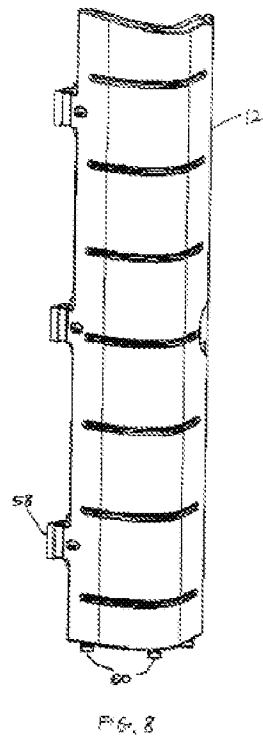


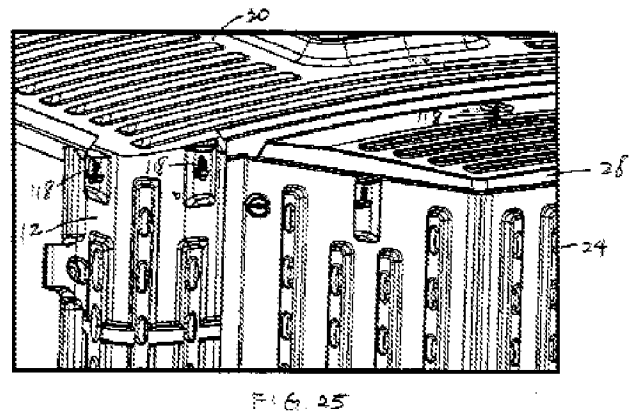
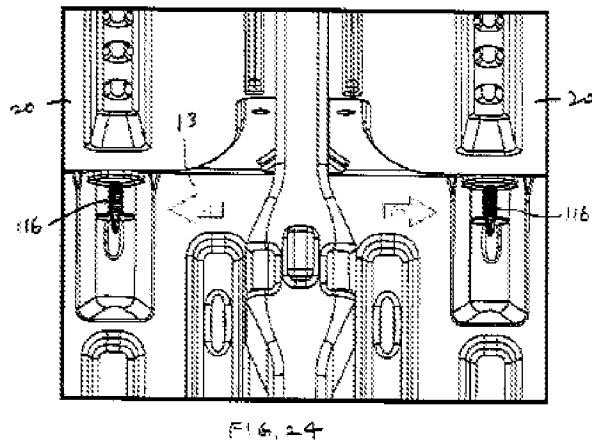
Reproduced from U.S. Patent No. 6,145,254

6. Regarding claim 8, Greene further discloses a left and right wall assembly, each with a first, second, and third panel (two "corner posts" 12 and "center post" 13, Fig. 1).
7. Regarding claims 9 and 17, Greene further discloses first and third panels ("corner posts" 12, Fig. 1) have a first end with attachment means for connecting a floor

Art Unit: 3633

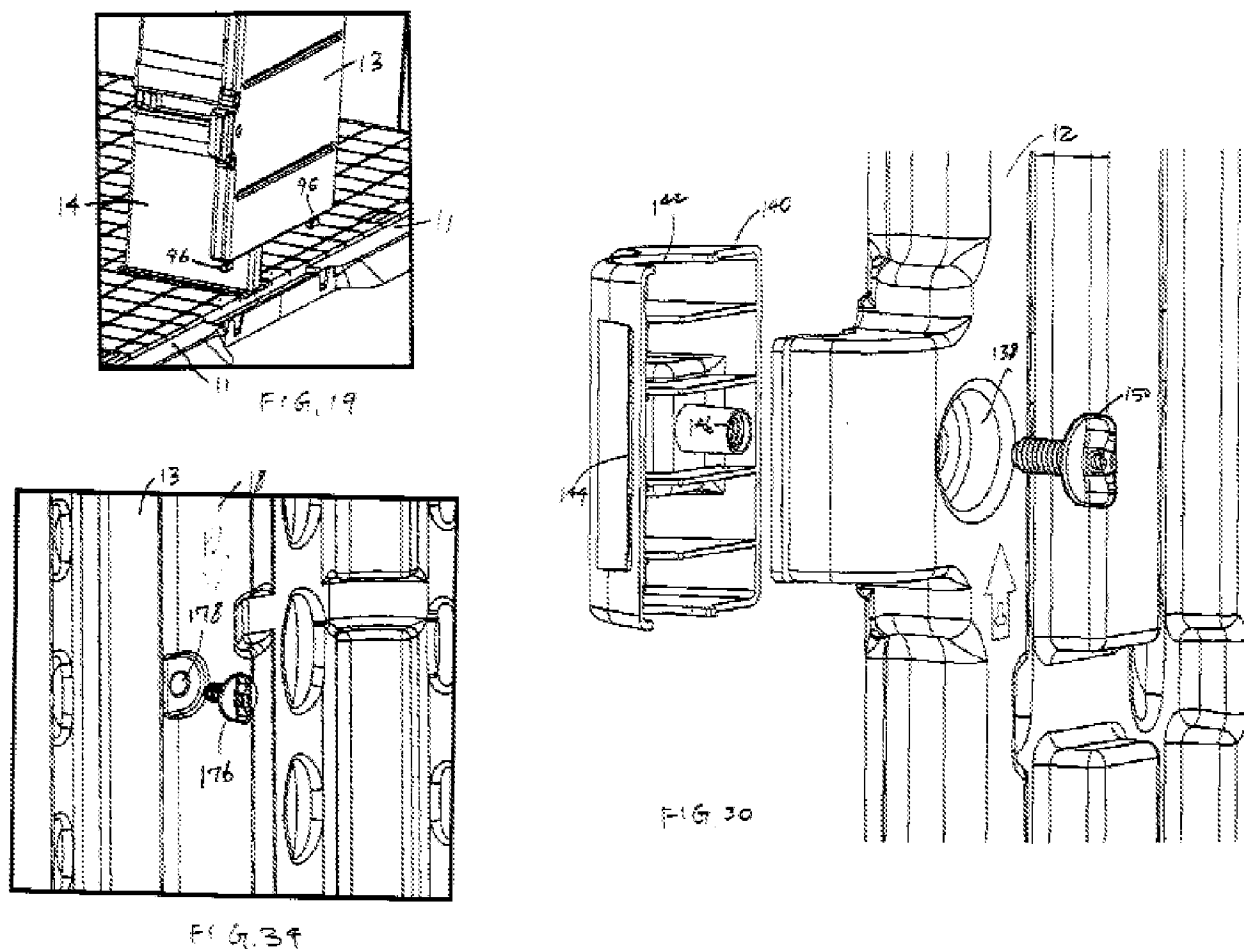
assembly ("protrusions" 60, Fig. 8), a second end with attachment means for connecting a roof assembly ("plastic bolts" 118, Fig. 25; "Fig. 25 shows the use of plastic bolts 118 to attach the roof panel 20 to the corner post 12 via threaded apertures provided along the top edge of the corner post 12," column 12, lines 13-16), one horizontal edge with perpendicular attachments (threaded apertures of "corner post," Fig. 15), and a second horizontal edge with coplanar attachments ("hinge supports" 58, Fig. 8).





Reproduced from U.S. Patent No. 6,796,087

8. Regarding claim 13, Greene further discloses second panels ("center posts" 13, Fig. 1) have a first end with attachment means for connecting a floor assembly ("protrusions" 96, Fig. 19), a second end with attachment means for connecting a roof assembly ("plastic bolts" 116, Fig. 24; "Fig. 24 shows the use of plastic bolts 116 to attach the roof panel 20 to the center post 13 via threaded apertures provided along the top edge of the corner post 13," column 12, lines 10-13), one horizontal edge with coplanar attachments ("hinge cover member" 140, Fig. 30), and a second horizontal edge with coplanar attachments ("threaded aperture" 178, Fig. 34).



Reproduced from U.S. Patent No. 6,796,087

9. Regarding claim 21, Greene discloses a rear wall assembly with two wall panel members ("upper wall" 74 and "lower wall" 68, Fig. 16).

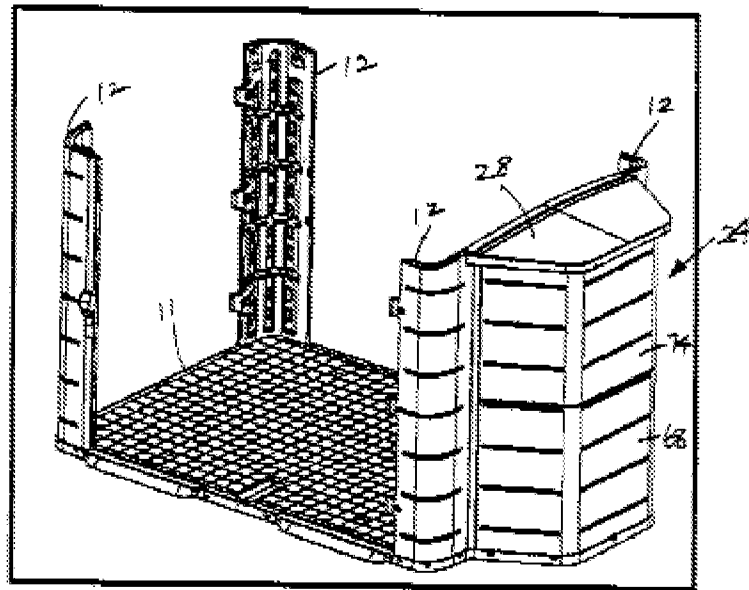


Fig. 16

Reproduced from U.S. Patent No. 6,796,087

10. Regarding claim 37, Greene discloses roof panels with strengthening ribs integrally formed in the bottom surface thereof ("roof panels" 20, Fig. 25).
11. Claims 10-12, 14-16, 18-20, and 28-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greene (U.S. Patent No. 6,796,087) in view of Silva (U.S. Patent No. 6,145,254) as applied to claims 1, 2, 5-9, 13, 17, and 21 above, and further in view of Paz et al. (U.S. Patent No. 6,250,022).
12. Regarding claims 10, 14, and 18, Greene in view of Silva discloses the claimed invention except for the first and second longitudinal ends using an attachment means consisting of at least one integrally formed socket. However, it is well known in the art to use a socket connection as an attachment means between a longitudinal edge and a roof or floor assembly. For example, Paz et al. teaches an

Art Unit: 3633

extendible shed comprising panels with integrally formed sockets for connecting longitudinal edges to floor or roof assemblies (“side panels” 34 and “conduits” 96, Fig. 3).

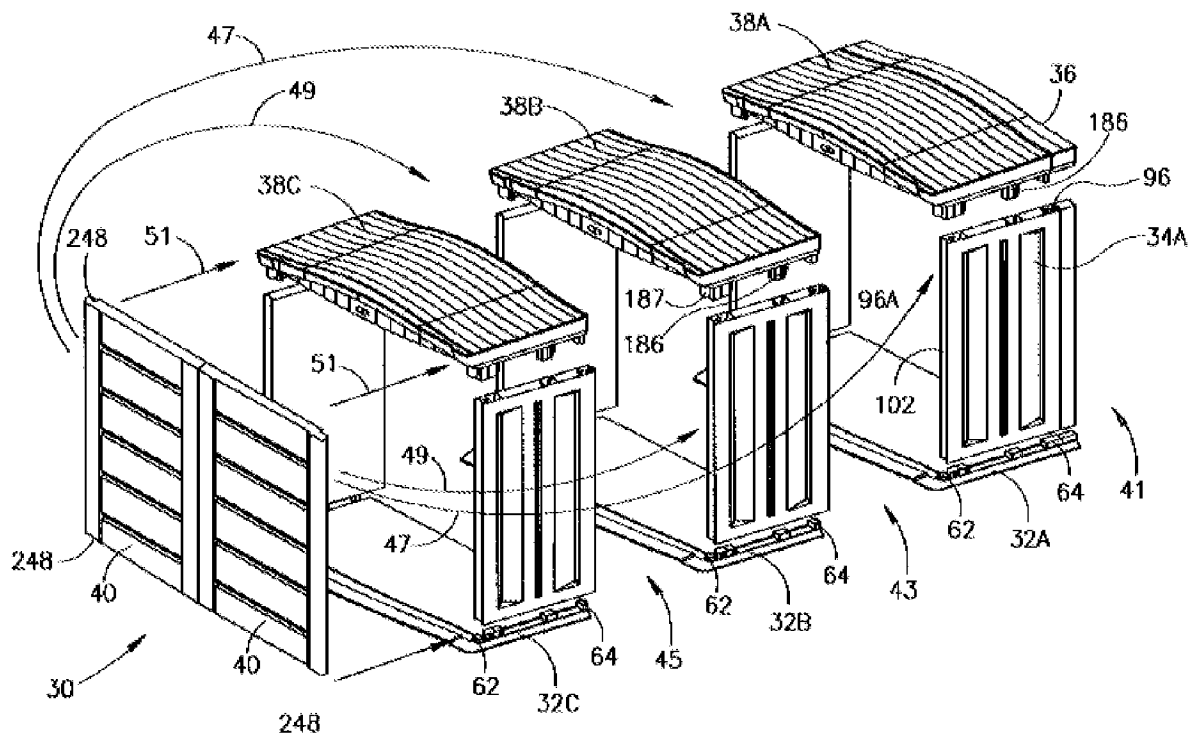


FIG.3

Reproduced from U.S. Patent No. 6,250,022

13. Regarding claims 11, 12, 15, 16, 19, and 20:

- a. Greene in view of Silva does not expressly disclose two semi-circular conduits with an aperture for accepting a dowel and placed in an overlapping relationship.
- b. Paz et al. discloses two semi-circular conduits (“upper clip” 290A and “lower clip” 290B, Fig. 14E) with an aperture (“semi-circular apex” 291, Fig. 14E) for accepting a dowel (“upper disc” 180A and “lower disc” 180B, Fig. 14E).

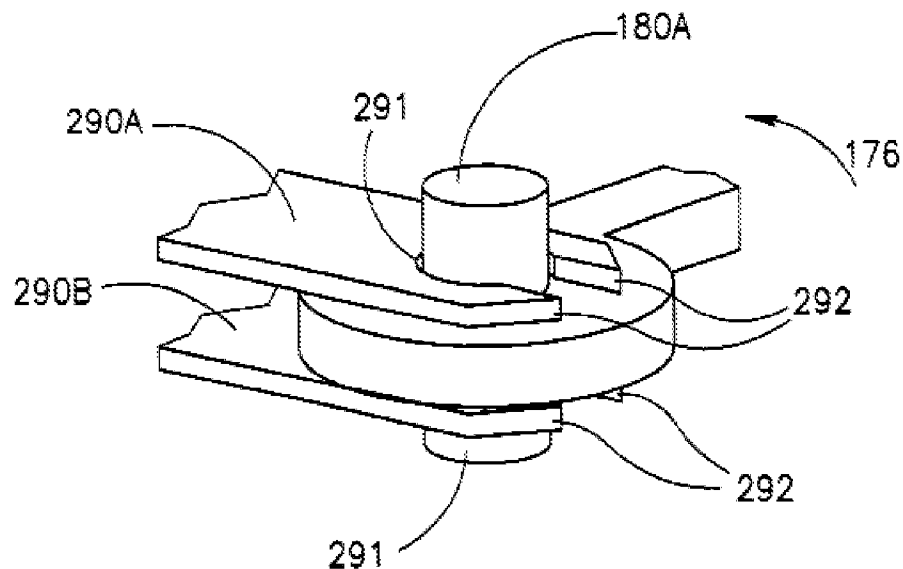


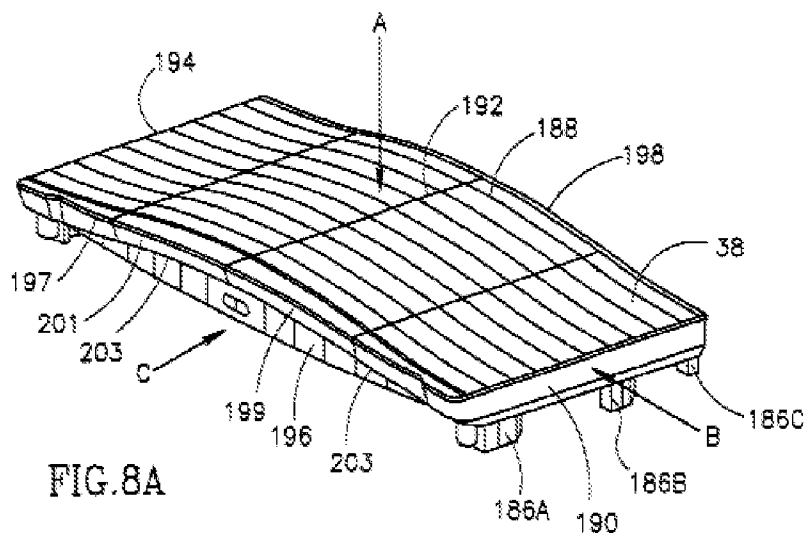
FIG. 14E

Reproduced from U.S. Patent No. 6,250,022

14. Regarding claim 28:

- a. Greene in view of Silva discloses a left and right door panel ("front doors" 16, Fig. 1).
- b. Greene in view of Silva does not expressly disclose headers attached to each door panel.
- c. Paz et al. discloses a header above door panels ("gable" 196, Fig. 8A).
- d. Paz et al. does not expressly disclose that the header has separate left and right sides corresponding to and for engagement with the left and right door panels below.
- e. Greene in view of Silva, and further in view of Paz et al., discloses the claimed invention except for separate left and right portions of the header

corresponding to the left and right door panels. It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the header from two separate pieces corresponding to the door panels below, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.



Reproduced from U.S. Patent No. 6,250,022

15. Regarding claims 29 and 31:

- a. Greene in view of Silva discloses a left and right door with several integrally formed sockets on longitudinal ends ("hinge supports" 134, Fig. 29) an edge with a conduit ("opening" 132, Fig. 29) with integrally formed hinge means ("hinge post" 130, Fig. 29), and a flat edge (Fig. 1).

- b. Greene in view of Silva does not expressly disclose that the left and right header pieces each have a plurality of locking posts cooperable with sockets located in each door panel.
 - c. Paz et al. discloses left and right header pieces each have a locking post cooperable with a socket located in each door panel ("bosses" 187, Fig. 8A).
 - d. Paz et al. does not expressly disclose a plurality of these locking posts.
 - e. Green in view of Silva, and further in view of Paz et al., discloses the claimed invention except for a plurality of locking post-socket joints. It would have been obvious to one having ordinary skill in the art to include more locking posts and sockets to further strengthen the connection, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.
16. Regarding claims 30 and 32, Greene further discloses hinge means with a C-shaped portion ("hinge support" 134, Fig. 29) arranged to cooperate with a hinge clip ("cover member" 140, Fig. 29).
17. Claims 1, 22, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Skov et al. (U.S. Patent No. 6,581,337) in view of Silva (U.S. Patent No. 6,145,254).
18. Regarding claim 1:
- a. Skov et al. discloses a panel system with assemblies for a floor, a pair of side walls, a rear wall, and a pivoting door that can be assembled on-site (Fig. 17)

and roof panels (110, Fig. 17) equipped with a plurality of strengthening ribs (170).

b. Skov et al. does not expressly disclose a telescoping roof assembly.

c. Silva discloses a retractable roof panel ("panel member" 50, Fig. 2).

Providing the roof of Skov et al. with telescoping ability as taught by Silva allows added space for maneuverability when inserting lengthy tools such as rakes or ladders into the utility shed.

d. Skov et al. and Silva are analogous art because both are from the field of endeavor of roofed structures.

e. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to equip the roof of Skov et al. with telescoping ability as taught by Silva, in order to aid in the insertion and removal of lengthy tools.

f. The examiner notes that, although the flanges 170 extending from the bottom of the roof panels are intended to connect adjacent panels together, they also function as strengthening ribs since they provide the panels with increased strength and rigidity.

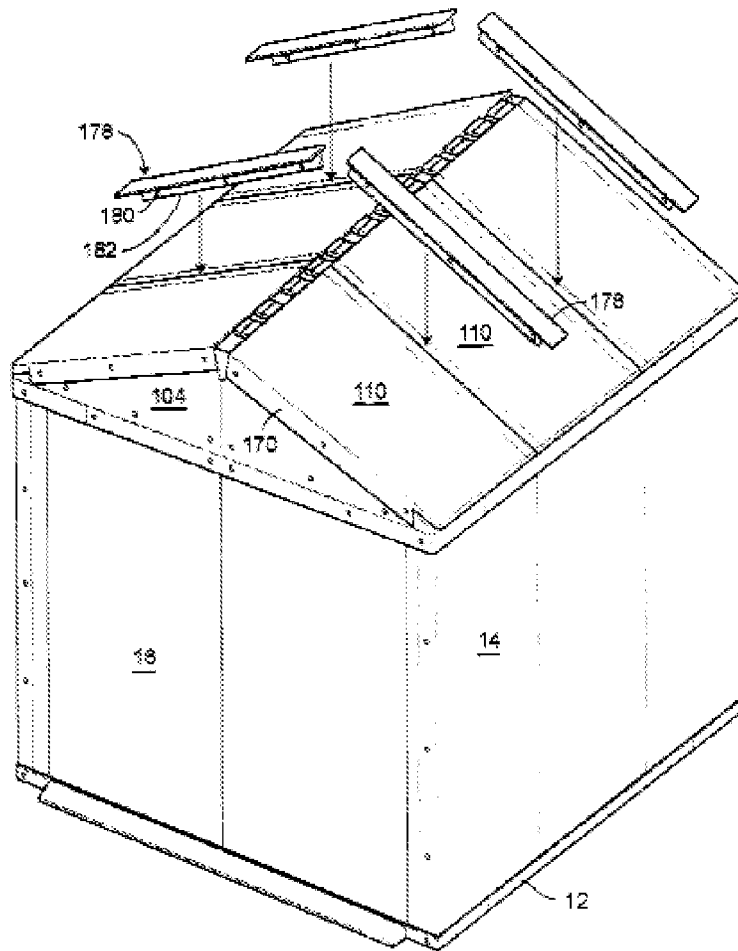


FIG. 17

Reproduced from U.S. Patent No. 6,581,337

19. Regarding claim 22:

- a. Skov et al. further discloses a left and right wall cap ("gables" 104, Fig. 17).
- b. Silva further discloses a fixed roof panel ("screen" 70, Fig. 1) and a telescoping roof panel ("panel" 50, Fig. 1).

Art Unit: 3633

20. Regarding claim 24, Skov et al. further discloses a roof panel arranged to accept a steel roof support (“panels” 110 accept “beams” 178, Fig. 17; “roof members 178...may be...fabricated from a variety of metals,” column 9, lines 1-6).

Allowable Subject Matter

21. Claims 23 and 25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
22. Claims 33-36 are allowed.

Response to Arguments

23. Applicant's arguments filed 07/02/08 have been fully considered but they are not persuasive.
24. Applicant argues that neither Greene nor Silva disclose a roof panel with a plurality of strengthening ribs capable of providing structural rigidity to the panel, and requests that the examiner specifically point out the ribs of Greene. However, as discussed in the rejection above and shown in amended Fig. 25, Greene does disclose a roof panel with a plurality of ribs on the underside thereof. These ribs are capable of providing strength and rigidity. Since all the claim limitations are met by Greene/Silva, the rejection stands.
25. The applicant also requests a specific section of the specification in which the function of such ribs as “strengthening ribs” is disclosed. The examiner notes that

Art Unit: 3633

ribs are inherently known to provide strength to the structure in which they reside, and that the claim language “constructed...panel” is essentially a recitation of functional language, and that the ribs of Greene need only be capable of performing these functions to meet the claim limitations.

26. Applicant argues that Paz fails to disclose the alleged missing limitations of claim 1, and therefore that the claims rejected using Paz are allowable. However, as discussed above, the combination of Greene/Silva discloses all the limitations of claim 1, and as such this argument is considered moot.
27. The examiner notes applicant's admission that Paz does, in fact, disclose panels with integrally formed sockets for connecting longitudinal edges to floor and roof assemblies.
28. Applicant argues that neither Skov nor Silva disclose a roof panel with a plurality of strengthening ribs capable of providing structural rigidity to the panel. However, as discussed in the rejection above, Skov does disclose a roof panel with a plurality of ribs extending from the bottom side thereof. These ribs are capable of providing strength and rigidity. Since all the claim limitations are met by Skov/Silva, the rejection stands.
29. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRANON C. PAINTER whose telephone number is (571)270-3110. The examiner can normally be reached on Mon-Fri 7:30AM-5:00PM, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Glessner can be reached on (571) 272-6843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/B. C. P./
Examiner, Art Unit 3633
08/05/08

/Brian E. Glessner/
Supervisory Patent Examiner, Art Unit 3633